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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,038	01/29/2001	Alan F. McCartney	80168.0095.001	9024

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EXAMINER
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VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 04/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

PPG

# Office Action Summary

Application No.

09/772,038

Applicant(s)

MCCARTNEY ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Application History***

1. This action is responsive to the application filing, Application filed on 1/29/2001.
2. Claims 1-20 are pending in the case, claims 1 and 10 are independent claims.

### ***Priority***

3. Applicant's claim for domestic priority of US provisional application 60/184/812, filed 2/24/2000, under 35 U.S.C. 119(e) is acknowledged.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "608" in Figure 6 has been used to designate both a "Get XSL" process step and "Get XML" process step. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
  - "401" on page 8, line 11.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "109", "110" and "111" in Figure 2.
- "608" in Figure 6.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The disclosure is objected to because of the following informalities:
- The disclosure recites those reference signs listed in paragraph 5 above, which are not shown in the drawings.
  - The disclosure fails to disclose those reference signs listed in paragraph 6 above, which are shown in the drawings.

Appropriate correction is required.

8. The use of the following trademarks has been noted in this application:
- "*Netscape Navigator*" on page 1, line 14; page 8, line 15.

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- "Microsoft Internet Explorer" on page 1, line 15; page 7, lines 17-18, page 8, lines 14 and 15; page 9, line 1.
- "HotJava" on page 1, line 15 (twice).
- "Sun Microsystems" on page 1, line 16; page 2, line 12.
- "JavaScript" on page 2, lines 11 and 12; page 8, line 2.
- "iBrowser" on page 7, lines 13 and 14; page 8, line 14 (twice).
- "ActiveX" on page 7, line 18.
- "Mozilla" on page 8, line 14.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
*"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. "*
10. Claims 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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11. Claim 4 recites the limitation "*the requested optimized document*" in second line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 fails to disclose an "*optimized*" document.
12. Claims 5-8 are rejected for fully incorporating the deficiencies of claim 4.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."*

14. Claims 1-3, 9-12 and 15-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Michael Floyd, "Building an XML Workbench" published by New Architect Online, May 1999 (hereinafter Floyd). (Note: references to Floyd in this action are made using the page and paragraph marks created by the applicant in the applicant's IDS submitted version of Floyd's paper.)
15. **Regarding independent claim 1**, Floyd recites: "*The final tool, XML Enabler, is a servlet that takes a HTTP request from a browser, and uses information in the HTTP header to determine which type of browser made the request. The servlet then selects an XSL style sheet from a collection of style sheets, transforms the data into HTML, and sends it back in a response*"

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(page 5, paragraph 5). Floyd further states: *"a system that stores its documents in XML format, then uses XSL to dynamically transform these documents"* (page 1, paragraph 3).

16. **Regarding dependent claim 2**, Floyd recites: *"a servlet that takes a HTTP request from a browser"* (page 5, paragraph 5).

17. **Regarding dependent claim 3**, Floyd recites: *"a system that stores its documents in XML format, then uses XSL to dynamically transform these documents"* (page 1, paragraph 3).

18. **Regarding dependent claim 9**, the claim is rejected for fully incorporating the deficiencies of the base claim.

19. **Regarding independent claim 10**, the claim is directed toward a system for the method of claim 1, and is rejected using the same rationale.

20. **Regarding dependent claim 11**, the claim is directed toward a system for the method of claim 2, and is rejected using the same rationale.

21. **Regarding dependent claim 12**, the claim is directed toward a system for the method of claim 3, and is rejected using the same rationale.

22. **Regarding dependent claim 15**, the claim is rejected for fully incorporating the deficiencies of the base claim.

23. **Regarding dependent claims 16 and 17**, Floyd recites: *"You can even define an XSL style sheet for each brand of browser you intend to support,*

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*and with a little browser detection serve HTML optimized for that specific browser"* (page 1, paragraph 3).

24. **Regarding dependent claims 18-20**, the claim is rejected for fully incorporating the deficiencies of the base claim.

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

26. Claims 4-8 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floyd in view of Fields et al. US Patent 6,605,120 filed 12/10/1998, patented 8/12/2003 (hereinafter Fields).

27. **Regarding dependent claims 4-8**, Floyd discloses the dynamic publishing of a web page using an XSL style sheet and an XML source document as described above. Floyd fails to disclose the caching of the generated web page, the XSL style sheet or the XML source document or using these cached components. Fields teaches caching the web page, the XSL style sheet and the XML source document. Fields discloses "Cached

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*Pages*" in Figure 2 at reference sign 131. Fields discloses "*Cache Page Parts*" in figure 5A at reference sign 423 (compare "*Page Parts*" to "*XSL style sheets and XML source*"). Fields teaches the selective use of cached elements. Fields recites: "*The invention encompasses several variations in the types of information parsed from the page and cached locally. Some of this information may be incorporated in the recast HTML page and some may be used for version checking*" (column 5, lines 45-47).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to combine the dynamic publishing of web pages of Floyd with the caching of web pages and their components of Fields, because "*The aim of caching pass-through web content is to maximize efficiency by minimizing network bandwidth requirements while preserving the transparency of the transaction*" (Fields, column 6, lines 10-13).

28. **Regarding dependent claims 13 and 14**, the claims are directed toward a system for the method of claims 4-8, and are rejected using the same rationale.

### ***Conclusion***

29. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-6,226,675	05-2001	Meltzer et al.
• US-6,313,835	11-2001	Gever et al.
• US-6,463,447	10-2002	Marks et al.


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- US-6,589,291 07-2003 Boag et al.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**STEPHEN S. HONG**  
**PRIMARY EXAMINER**

Gregory J. Vaughn  
April 16, 2004